IN THE

UNITED STATES

CIRCUIT COURT OF APPEALS

FOR THE

NINTH CIRCUIT

JOHN M. KLEIN,
Plaintiff in Error,

vs.

CITY OF SEATTLE,
Defendant in Error.

No. 287.

In Error to the United States Circuit Court, District of Washington, Northern Division.

BRIEF OF DEFENDANT IN ERROR.

FRANK A. STEELE,
Attorney for Defendant in Error.

JOHN K. BROWN,
Corporation Counsel, of Counsel.

METROPOLITAN PRINTING & BINDING CO., SEATTLE

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I.

The assignment of errors in the record is unavailing for any purpose:

1. The exceptions taken to the conclusions of law announced by the court (page 31 of record) are futile.

They are like exceptions to a verdict.

Merchantile Trust Co. v. Wood 60. *Fed.* 346.

2. The exception to the judgment (page 32 of record) is likewise of no avail.

Dietz vs. Lymer 61, *Fed.* 793.

Florida Central Ry. V. Cutting 68, *Fed.* 586.

3. It appears from the record (page 33 et seq.) that the so-called assignment of errors was never filed in the court below as required by the eleventh rule of this court.

The failure to file an assignment of errors has been held good ground for dismissal.

Dufour vs. Lang 54. *Fed.* 913.

4. The errors assigned are based on futile exceptions.

(1 *and* 2 *supra.*)

5. The assignment of errors is of no avail because it does not "set out separately and particularly each error asserted and intended to be urged" according to the intent and judicial interpretation of the eleventh rule.

Doe vs. Waterloo Min. Co. 70, *Fed.* 455. (*loc. cit.* 461.)

Oswego vs. Travelers Ins. Co. 70, *Fed.* 225.

Florida Central Ry. Co. vs. Cutting 68, *Fed.* 586.

6. The exception to the judgment in the case at bar (page 32 of record) is similar to that in "Dietz

v. Lymer" supra. viz: "To the foregoing judgment plaintiff excepts."

The fourth error assigned, viz: To the rendering of judgment, is practically the same as that condemned in "Florida Central Ry. Co. v. Cutting," supra., and "Doe v. Waterloo Min. Co." supra.

The first, second and third assignments are futile under the principle announced in "Merchantile Tr. Co. v. Wood," supra.

The vigorous enforcement of the eleventh rule is amply justified by Judge Knowles of this court in "Doe v. Waterloo Min. Co." supra., in these words: "The object of setting forth the assignments of error is to apprise the opposite counsel and the court of the particular legal points relied on for a reversal of the judgment of the trial court. The attempt to make the assignments more particular in the brief is not proper." There is no specification showing wherein the judgment is not supported by the finding or advising either counsel or court of any alleged error or difficulty.

Grape Creek Coal Co. vs. Farmer's L. & T. Co. 63. *Fed.* 891.

It appearing then, that no assignment of errors has ever been filed in the court below, and it further appearing, although the court should assume the filing of the assignment, that it contains no such specifications of error as will enable the court to review any

act of the court below. the judgment should be affirmed.

Press vs. Davis, 54, *Fed.* 267.

Smith vs. Sac County, 11. *Wall* 139.

II.

The only question for determination upon the merits, is: Does the special finding in any view, support the judgement?

Should the court examine the merits of the case, it will be evident at once that the foregoing is the only question before the court.

This cause was tried by the court without the intervention of a jury in accordance with a stipulation conformable to the requirements of Sec. 649 R. S.

A special find was made by the court (page 20 et seq. of the record) and upon such finding a judgment was rendered and entered for the defendant in error. (page 32 of record).

There is no bill of exceptions in the record. It follows, therefore, as a preliminary proposition, that the record presents but the one possible question for the determination of this court upon the merits.

Merchantile Trust Co. vs. Wood. 60, *Fed.* 346.

Martinton vs. Fairbanks, 112, *U. S.* 670.

Lehnen vs. Dickson, 148, *U. S.* 71.

III.

The special finding supports the judgment.

1. The finding sets forth the specification and claims of the Klein patent. (Page 26 et seq. of record.)

The mere reading of the specification and claims can lead to but one conclusion. The device upon its face is not patentable for want of invention. It is a mere mechanical contrivance. The patent is therefore void.

2. The finding sets forth the state of the art at and prior to the application for Klein's patent. (Page 21 et seq. of record.)

An examination of the findings on the state of the art leads to but one conclusion. All the objects, purposes, designs and results of the Klein device had already been obtained in substantially the same way by substantially the same means. Its novelty, if any, consists in the substitution of one well known material for another. The patent, therefore, is void for want of patentable novelty and for want of invention in view of the state of the art.

IV.

The Klein patent is void for want of invention and novelty both on its face and in view of the state of the art.

The two subdivisions of the foregoing proposition can be most satisfactorily discussed together.

The specifications of the patent so far as material to a discussion of the question in issue are as follows:

"My invention relates to an improved pin or support for fixing and holding in place a glass insulator on cross-arms of telegraph poles * * * as hereinafter more fully described. My improvement consists in providing an insulator pin of metal having a head of larger diameter than the body of the pin, on which is a screw-thread, or portion of a thread of proper size to be inserted into and engage with the screw socket in the insulator.

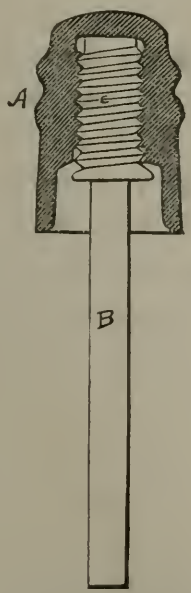

Fig. 2.

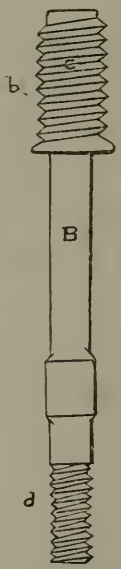

Fig. 3.

"Fig. 2 is view of the pin or support in detail with the cap or insulator glass in section. Fig. 3 is a view of the pin. 'A' represents a glass insulator of the kind generally employed on telegraph poles and other situations to afford points of support for electric wires, in which is a socket with a spiral thread or groove for fastening it upon its pin.

"To provide a strong and permanent supporting pin I take a length of metal rod, preferably of wrought iron, and upon one end I form a head (b) of greater diameter than the body of the rod and of the size to be received into the socket or opening in the glass 'A.' This head is provided with a spiral thread or groove (c) to engage with the thread in the socket of the glass. To form the head or enlarged portion (b) that receives or incloses the glass (A), I can proceed in several ways, but the simplest and least expensive method I have found, is to place the end of the rod (B) within a suitable mold and then pour in themolten metal around it,

"the mold employed for this purpose having a groove or thread in its interior. A cheap and ready means of forming the head (b) is to use solder and lead and in such case the glass insulator itself can be used as a mold, the end of the pin (B) being held in the center of the socket in the glass while the molten metal is being poured in around it."

The claims are as follows:

"1st. The wrought metal pin 'B' provided with a

soft metal head 'b' which is grooved or threaded to fit into and engage with the socket in an insulator for supporting electric wires substantially as set forth."

"2nd. An insulator pin or support for electric insulators having a wrought metal body and a screw-threaded head of larger diameter than the body of the pin of cast metal, substantially as set forth.

The special finding as to the state of the art is substantially as follows:

"The pins which were first used were ordinary screw wooden pins upon which screw insulators were attached. There were also prepared and used, iron pins smaller in circumference and otherwise than the wooden pin; to which iron pin there was attached a wooden screw-head to which the insulator was attached in the same manner as it was fastened to the wooden pin. This wooden screwhead was attached to the iron pin by boring a hole through it and running the iron pin into the same. Another device was manufactured by taking a piece of wood and driving the same into the glass insulator and boring a hole in the wood and forcing the iron pin therein. In other words the wood was used as a bushing. Examples of these three pins are shown by "Defendant's Exhibits 1, 14 and 2." Other pins were also used which were made by using as bushing or filling plaster-of-paris, cement, rags, white lead or sheet-lead. Another device was an iron pin with an iron screw-head to which the insulator was attached. This is shown by "Defendant's Exhibit 15." The use of molten lead and other soft metals as a

tie or bushing between iron and other hard metals and substances, has been long well known, and wood, lead, gutta percha, cement, plaster of paris, etc·, have been used for a long period of time for like purposes."

The following preliminary propositions are submitted as the rules applicable to a determination of the case:

1. The court will take judicial notice of matters of common knowledge or things in common use in determining patentability.

Phillips vs. Detroit, 111. *U. S.* 605.

Brown vs. Piper, 91, *U. S.* 37.

2. The question of patentability in the light of common knowledge is one of law for the court.

Mahn vs. Harwood, 112, *U. S.* 354.

Cleveland Faucet Co· vs. Vulcan Brass Co., 72, *Fed.* 505.

3. The special finding of the trial court is conclusive upon this court as to all the facts therein set forth.

Merchantile Trust Co. vs. Wood, 60, *Fed.* 346.

Alexander vs. Machan, 147, *U. S.* 72.

Lehnen vs. Dickson, 148, *U. S.* 71.

It logically follows that the facts found by the trial court relative to the state of the art are before this court for consideration on precisely the same plane as

those matters which are within the common knowledge of all persons and therefore, judicially known to the court.

4. A patent must combine utility, novelty and invention. It may embrace utility and novelty to a marked degree and still be the result of mechanical skill and not invention.

Sax vs. Taylor Iron Whrks, 30, *Fed.* 835. (*loc. cit.* 838.)

Johnson vs. Pac. Rolling Mill, 47, *Fed.* 586. (*l. c.* 589.)

5. The substitution of one well known element or material for another is not invention.

Vulcanized Fibre Co. vs. Taylor, 49, *Fed.* 745.

Nat'l Surface Guard Co. vs. Merrill, 49, *Fed.* 157.

Hicks vs. Kelsey, 18, *Wallace* 670.

Hotchkiss vs. Greenwood, 11, *Howard* 248.

6. Neither a combination of old elements such as are found in the patent in suit, nor the use of an old device for a new purpose constitutes a patentable invention.

Busell Trimmer Co. vs. Stevens, 137, *U. S.* 433.

Rickendorfer vs. Faber, 92, *U. S.* 347.

Dunbar vs. Meyers, 94, *U. S.* 187.

Thompson vs. Boissler, 114, *U. S.* 1.

Atlantic Works vs. Bradley, 107, *U. S.* 192.

Brown vs. Piper, 91, *U. S.* 37.

7. A difference or change in mechanical construction to remedy an obvious defect in a machine or device is not patentable.

Hollister vs. Mfg. Co. 113, *U. S.* 59.

Gardner vs. Herz, 118, *U. S.* 180.

Carter vs. Baker, 1, *Sawyer* 512.

Tatham vs. Leroy, 2, *Blatchford* 486.

8. In determining the patentability of this device, the court will call to its aid the common knowledge and experience and observation of intelligent men, together with the state of the art as disclosed by the finding, which means simply, the method, the manner and form in which similar results have been accomplished prior to the date of the alleged invention, and if from such general knowledge and the state of the art as presented by the finding, it appears that the device in controversy is the carrying forward of a previously known idea and a mere change in form by which the same result is accomplished as heretofore and by other devices, only in a simpler and more convenient method, or discloses the expected skill of an competent mechanic familiar with his calling and with the results to be obtained, or involves only the exercise of the ordinary faculties of reasoning upon the necessities of the case before him, together with the materials supplied by a special knowledge of the work to be done and the skill which results from the habitual and intelligent practice of the art or calling in which he is engaged; then the device is not patentable.

Hollister vs. Benedict Mfg. Co. 113, *U. S.* 59.

Thompson vs. Boissler, 114, *U. S.* 1.

Dunbar vs. Meyers, 94, *U. S.* 187.

Atlantic Works vs. Bradley, 107, *U. S.* 192.

9. A device which discloses merely mechanical skill, however useful and advantageous it may be, or however new in the form or shape in which it is produced, is not an invention, nor does it make it patentable that it produces the same results as have been before produced, but in a better and more efficacious or convenient form, but it must embody some new idea or principle not before known or used for accomplishing such results. In other words, the device to be patentable must be a discovery.

Last cases supra.

10. In determing patentability one key to the enquiry is, did it require the discovery of something new, or experiments to ascertain whether the device would work or non to produce the sought for result. If not, then it is but a mechanical substitute.

Carter vs. Baker, 1, *Sawyer* 512.

Tatham vs. Leroy, 2, *Blatchford* 486.

11. Invention, in the sense of the patent law, is the finding out, contriving or creating something new and useful which was not and did not exist before; the bringing to light something which lay hidden from

vision; and it is not enough to support a patent that the thing shall be new in the sense, that in the shape of form in which it is produced it shall not have been known before, but it must have been an invention or discovery and an intelligent mechanic is chargeable with knowledge of the state of the art upon which he is called to exercise his skill.

Ransom vs. Mayor, 1 *Fish* 252.

Conover vs. Roach, 4 *Fish* 12.

Thompson vs. Boissler supra., 114 *U. S.* 1.

Busell Trimmer Co. vs. Stevens, 137 *U. S.* 433.

12. An invention, under the patent law, is something which "springs from that intuitive faculty of the mind put forth in the search for new results or new methods, creating that which had not before existed or bringing to light that which lay hidden from vision."

Hollister vs. Mfg. Co., *supra.*

Thompson vs. Boissler, *supra.*

13. It is not the object of the patent laws to grant a monopoly for "every shadow of a shade of an idea."

Atlantic Works vs. Bradley, 107 *U. S.* 192.

Brown vs. Piper, 91 *U. S.* 37.

IV.

It now becomes pertinent to examine the Klein patent and the special finding in the light of the foregoing principles.

First, then, as to the scope of the patent. The device consists of an iron pin with an enlarged head, threaded to engage with the ordinary glass insulator, used in conveying electric wires, and forming a support for it.

Claim one describes the device in part as "the wrought metal pin B," etc.

Claim two gives the description "having a wrought metal body," etc.

The specification, line thirty-five, proceeds "I take a length of metal rod preferably of wrought iron," etc.

The claims and specification must be construed together in determining the scope of the patent. It therefore is evident that the kind of metal, whether it be of brass, copper or iron, whether it be wrought or cast, is immaterial.

The first element of the claim is for a metal pin for insulators.

The general use of a wooden pin for such a purpose, long prior to the Klein patent is matter of common knowledge, or if not, the fact is established by the sixth paragraph of the special finding. (See "Defendant's Exhibit No. 1.")

We have then as the first element of the patent a substitute of metal for wood. But such a substitution had been made prior to Klein's alleged invention as disclosed by paragraphs eight, nine and eleven of the special finding. (See "Defendant's Exhibits 2, 14 and 15.)

But even if Klein had been the first one to use metal in lieu of wood it would not involve invention. The "cattle guard," "wagon reach" and "door knob" cases are in point.

Nat'l Surface Guard Co. vs. Merrill, 49, *Fed.* 157.

Hicks vs. Kelsey, 18, *Wallace* 670.

Hotchkiss vs. Greenwood, 11, *Howard* 248.

As a second element of the first claim, the head of the pin is described as "grooved or threaded," etc.; in the second claim as "screw threaded," etc. The specification, line forty-one, describes the head as follows: "With a spiral thread or groove to engage with the thread in the socket of the glass and this forms the means by which the insulator is secured to the pin."

It is matter of common knowledge that the screw has been used almost from the inception of telegraphy for the purpose of securing the insulator to a wooden pin. In any event the fact is so found by the court in the sixth paragraph of the special finding. (See Defendant's Exhibit No. 1.)

The screw had also been used on metal pins long prior to the Klein patent. The fact is so found in

paragraphs eight and eleven of the special finding. (See Defendant's Exhibits 14 and 15.)

But if such were not the case; if Klein had been the first person to secure an insulator to its pin by means of the screw, still it would not be in any sense invention; for in view of the common knowledge we possess of the screw and its uses for fastening together two objects, it would be the obvious means of accomplishing the result. An obvious method of doing a thing can never be the subject of a patent. Such a method is merely mechanical.

Proceeding with the analysis, we find the further description in the first claim, "a soft metal head." At this point the first and second claims diverge somewhat in their scope. Claim one in its entire description is "the wrought metal pin provided with a soft metal head which is grooved or threaded," etc.

It is evident that neither the metal pin nor the screw head, nor the two combined, constitute any patentable feature of the first claim.

"A soft metal head," therefore is the only material part of the device so far as the first claim is concerned.

It is noticeable that under this claim it is immaterial whether the body of the pin be larger or smaller than the head. It is likewise of no moment whether the head be cast on the pin or wrought out of it. The whole pin may be of lead, solder, copper or any of the alloys known to trade as soft metals—a pin identical

in form and shape with the iron pin described in paragraph eleven of the special finding. (Defendant's Exhibit No. 15.)

The making or using of such a pin would infringe claim one, for what though the body be soft metal, it is "provided with a soft metal head;" the soft metal head "is grooved or threaded;" the body of the pin is "wrought metal."

What then have we in claim one but a substitute for defendant's exhibit 15? and a substitute of metal for metal; lead, or some alloy known as a soft metal, for iron, steel or the like.

The third point in claim two is a "head of larger diameter than the body of the pin, of cast metal." This is the vital part of claim two for it has already been made evident that neither "a wrought metal body" nor a screw-threaded head," nor the two combined present any patentable features.

The question arises then upon "a cast metal head of larger diameter than the body of the pin."

Considering this element of the claim it is noticeable that it is immaterial whether the head be of hard or soft metal. It is simply to be "of larger diameter than the body of the pin" and of "cast metal." It is also worthy of note that nowhere in the specification is the head described as of soft metal, nor are any words used to indicate what character of metal should be used in the construction of the head other than "A very cheap and ready means of forming the head is to

use solder and lead, and in such cases the glass insulator itself could be used as a mold, the end of the pin B being held in the center of the socket in the glass while the molten metal is being poured in around it."

It is matter of common knowledge that a metal head of larger diameter than the pin could be welded on to it or wrought out of it and an instrument identical in form, use and result produced and therefore whether the head is of cast or wrought metal is immaterial.

So likewise as to the body of the pin; it is immaterial whether it be of wrought or cast metal, for the substitution of cast iron could under no possible conditions be invention, and if not invention, then the use of cast for wrought iron would infringe a patent where the claim was for wrought iron, for it is a well settled principle that substitution of equivalents will no more avoid infringement than it will support invention.

It follows then that the second claim is simply for a metal pin with a metal head larger than the body.

Let the iron pin, defendant's exhibit 15, be put upon the lathe and its diameter below the collar reduced one fourth inch, would not the result be a device completely infringing claim two? Surely there has been produced a pin, "having a metal body and a screw threaded head of larger diameter than the body of the pin."

Furthermore it appears by the special findings, para-

graph eight, that an insulator pin "having a wrought metal body and a screw-threaded head of larger diameter than the body of the pin" was commonly used before the Klein patent. True the "screw threaded head" was of wood but there is no element of invention in substituting cast iron or lead or any other metal for wood to perform the same office in the same way. It may perchance be better, more efficacious, but it is merely mechanical--"a shadow of a shade of an idea."

Does such a thing "spring from that intuitive faculty of the mind put forth in the search for new results or new methods?" Is it the "creating that which had not before existed?" Is it a "bringing to light what lay hidden from vision?"

But let us examine this wondrous product of genious further.

Let the substantial parts of the two claims be consolidated and a new claim made for the great inventor. We then produce, "An insulator pin having a wrought metal body and a screw-threaded head of larger diameter than the body of the pin, of soft cast metal."

Now let the specification broaden the new and extended claim, if it will, and illustrate the intricate, novel and ingenious method of construction: "Place the end of the rod within a suitable mold and then pour in the molten metal around it; the mold having a groove or thread in its interior. A very cheap and

ready means of forming the head is to use solder or lead and in such case the glass insulator itself could be used as a mold; the end of the pin B being held in the center of the socket in the glass while the molten metal is being poured in around it."

It seems then that it is immaterial of what the head may be constructed if it be of soft metal. (In the light of the specification is it even material whether the head be of soft metal?) It is likewise of no moment whether it be cast in a mold and the insulator afterwards screwed on; or whether it be cast in the insulator itself and afterwards screwed off.

There is but one result to be obtained in view of either the claims or specification, viz: To secure an insulator to a metal rod of less diameter than the socket of the glass.

To obtain that result this inventive genious either puts the rod in a threaded mold and pours the molten metal around it or at his or my pleasure, places the rod in the insulator and pours in the melted lead.

Has this result—securing an iron pin of less diameter than the socket of the glass, to the insulator—ever before been accomplished?

The special finding, paragraphs eight, nine and ten give some details. The result had been attained long prior to the Klein patent by means of a wooden screw on the iron pin; by means of a wooden bushing driven into the insulator, into which the pin was driven; by plaster of paris and cement poured into the

insulator and around the pin in the same manner that Klein uses the lead; by means of rags and white lead in combination as a luting; by the use of sheet lead as a bushing.

What then is there in Klein's use of molten metal but a mere substitute for the several fillings, bushings or lutings above described? What though his device performs its office to better advantage or more efficaceously.

The purpose and the result are same; it acts in the same way, under the same conditions for like ends.

The use of molten lead and other plastic substances that solidify, as a tie between stone, glass, earthenware and iron steel and other metals is a matter of such general and common knowledge coming under our observation day by day in countless ways that it is sufficient of itself to avoid this patent in its entirety; but as though to clinch the whole matter, the court found the fact in the twentieth paragraph of the special findings.

The iron fence brace is secured to the stone post, the steel spindle to the porcelain door knob by molten lead. Numerous other like instances might be given.

The patentee describes the advantages of his pin as follows:

"I can adapt my improved pin to the form and style of insulators in general use." The same may be said of defendant's exhibits 1, 14, and 15, described in

paragraphs six, eight and eleven of the special finding.

"It requires only a small hole in securing it to a cross-arm." This is true also of defendant's exhibits 2 and 14 and the devices described in paraph ten of the special finding.

"It is out of contact with the inner sides of the glass and the insulation more perfect." Like advantages may be predicated of the exhibits 2 and 14 and those described in paragraph ten of the finding.

"It will stand great weight and will bend and not break off." The same desideratum is found in defendant's exhibits 2, 14 and 15 and the devices described in the tenth paragraph of the findings,

These are all the advantages discovered by Klein, save that "lead and solder are cheap and ready." He ought to have gone further and informed the world that lead is ductile, maleable and fuseable at a low degree of heat. This additional information would undoubtedly have been as surprising as his other discoveries.

I submit that it will require greater ingenuity to find the patentable feature of Klein's device than was required to produce it. Genius never gave birth to this child of leaden head and attenuated body.

Judge Hanford in the opinion rendered below has well said: "Now, all that can be claimed as the invention in this case is the combination consisting in the use of iron in place of wood for a pin and lead in

place of rags, wood or cement for a filling; and the process of making a firm union of the lead head and iron pin; and, in my opinion, there is nothing in this that amounts to an invention. It seems to me that any person of intelligence directed to take an iron pin and glass insulator and insert one in the other and make a firm union between the two would discover that this was, obviously, a good method for doing that very thing."

And now, in closing the discussion of the patentability of Klein's device, I desire to suggest some questions based upon the propositions submitted as determinative rules and upon the foregoing analysis of the patent, which seem to be pertinent and to call for answers from the plaintiff in error.

Is the Klein device anything more than the carrying forward of a previously known idea and a mere change in form whereby the same result is accomplished as heretofore any by other devices?

Does it disclose anything beyond the expected skill of a competent mechanic familiar with his calling and with the results to be obtained?

Is there more involved in its construction than the exercise of the ordinary faculties of reasoning on the necessities of the case, together with the materials supplied by a special knowledge of the work to be done and the skill which results from the intelligent practice of the calling?

Does the device embody any new idea or principle not before known or used for accomplishing such results?

What discovery in mechanics, science or the arts has the patentee made?

Did it require any experiments to ascertain whether Klein's device would work or not to produce the results sought for?

What has Klein found out, contrived or created that is new, or what has he brought to light that lay hidden from vision, or that the simplest mind could not conceive or did not already know and understand?

Is there any element of the device that is not a substitute for some well known equivalent?

What advantageous results does it produce that are not produced by the several pins in the record as exhibits?

What element of merit can be claimed for it other than the exhibition of mechanical skill?

Is not every element, feature, principle, idea and result claimed for the Klein device fully disclosed by the state of the art as set forth in the special finding?

It is hardly possible that responses can be made to any of the foregoing inquiries other than such as have been contended for in the preceeding analysis of the patent.

Therefore, with full confidence in the result, it is respectfully submitted that the finding supports the judgment and that there is no element of patentability in the Klein device.

FRANK A. STEELE,

Attorney for the City of Seattle, Defendant in Error.

JOHN K. BROWN,

Corporation Counsel, of Counsel.